



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/349,708	07/08/1999	CHARLES WILLIAM BERTHOUD	BERTHOUD-16-	7016

7590 12/05/2001

FARKAS & MANELLI PLLC
2000 M STREET NW
7TH FLOOR
WASHINGTON, DC 200363307

EXAMINER

BUI, BING Q

ART UNIT	PAPER NUMBER
----------	--------------

2642

DATE MAILED: 12/05/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/349,708

Applicant(s)

Berthoud et al

Examiner

Bing Bui

Art Unit

2642



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jul 8, 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 2642

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Norris et al (US Pat No. 5,805,587).

Regarding claim 1, with respect to Figure 1, Norris et al teach the invention as claimed, a system for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but-busy party is accessing the Internet over the same telephone line, comprising:

Internet communication module (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);

and

a message formatter (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);

wherein said Internet communication module is adapted to cause said message formatter to send a notification message to said called-but-busy party upon request from a remote telephone user (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Art Unit: 2642

Regarding claim 2, with respect to Figure 1, Norris et al teach the invention as claimed, an apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said remote telephone user is a central office (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Regarding claim 3, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said remote telephone user is a party trying to establish a telephone call with said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 4, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising:

a call related information receiver (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5);
wherein call related information regarding a calling party is included with said notification message (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 5, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

Art Unit: 2642

call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said call related information receiver is a Caller ID receiver (Fig 6 and col 8, ln 20-48).

Regarding claim 6, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: said notification message is a textual message (Fig 6 and col 8, ln 20-48).

Regarding claim 7, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 6, wherein said textual message is an e-mail message (Fig 6 and col 8, ln 20-48).

Regarding claim 8, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising said notification message includes an audibly playable data file (Fig 6 and col 8, ln 20-48).

Regarding claim 9, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone

Art Unit: 2642

call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, wherein said audibly playable data file automatically plays when received on a computer terminal of said called-but-busy party (Fig 6 and col 8, ln 20-48).

Regarding claim 10, with respect to Figure 1, Norris et al teach the invention as claimed, apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 1, further comprising: a data signal detector adapted to detect likely Internet usage of said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 11, with respect to Figure 1, Norris et al teach the invention as claimed, the apparatus for notifying a called-but-busy party of an incoming telephone call attempt over a telephone line while the called-but busy party is accessing the Internet over the same telephone line according to claim 10, wherein said notification message includes information regarding likely Internet usage of said called-but-busy party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 12, with respect to Figure 1, Norris et al teach the invention as claimed, a method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user, comprising:

Art Unit: 2642

uniquely identifying an Internet user via a telephone call (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5); and

notifying said uniquely identified user that said calling party is attempting to call said Internet user over said telephone line (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 13, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from said calling party (Abstract; Figs 4-5 and col 4, ln 6-col 8, ln 5).

Regarding claim 14, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising receiving a notification request from a central office (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Regarding claim 15, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, further comprising determining at a central office a likelihood that said Internet user is connected with said Internet (Fig 1, item 50 and col 5, ln 48-col 6, ln 15).

Art Unit: 2642

Regarding claim 16, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is an e-mail message (Fig 6 and col 8, ln 20-48).

Regarding claim 17, with respect to Figure 1, Norris et al teach the invention as claimed, the method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user according to claim 12, wherein said notification is a n audibly playable message (Fig 6 and col 8, ln 20-48).

Regarding claim 18, with respect to Figure 1, Norris et al teach the invention as claimed, a method for notifying a n Internet user of a telephone line that a calling party is attempting to connect with said Internet user, comprising:

determining at a central office a likelihood that said Internet 10 user is connected with said Internet (Fig 1 and col 5, ln 48-col 6, ln 15); and

notifying a n attempted calling party to said Internet user of said likelihood (Fig 1 and col 5, ln 48-col 6, ln 15).

As to claims 19-22 , they are rejected for the same reasons set forth to rejecting claims 12-15, respectively.

As to claims 23-24, they are rejected for the same reasons set forth to rejecting claims 7-8, respectively.

Art Unit: 2642

As to claim 25 , it is rejected for the same reasons set forth to rejecting claim 18.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

O'Horo et al (US Pat No. 5,519,767) disclose a call waiting feature supported on a voice-and-data modem.

Gregorek et al (US Pat No. 5,557,658) disclose a telecommunication system including voice, data or multimedia network, adapted for allowing a called station connected to the first call from a first calling party at a first network address to receive a second call from a second calling party at a second network address.

Foladare et al (US Pat No. 5,982,774) disclose a system in which a caller interrupts a called party while the called party connected with an Internet session.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bing Bui whose telephone number is (703) 308-5858. The examiner can normally be reached on Monday through Thursday from 7:30 to 5:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar, can be reached on (703) 305-4731. The fax phone number

Art Unit: 2642

for the organization where this application or proceeding is assigned is (703) 872-9314 and for formal communications intended for entry (please label the response "EXPEDITED PROCEDURE") or for informal or draft communications not intended for entry (please label the response "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

BING BUI
Nov 30, 2001


AHMAD MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600